

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number Q78133
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number 10/698,438	Filed November 3, 2003
	First Named Inventor Keisuke KII	
	Art Unit 1794	Examiner Victor S. CHANG
	<small>WASHINGTON DC SUGHRUE/265550</small> <b>65565</b> <small>CUSTOMER NUMBER</small>	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.		
This request is being filed with a notice of appeal		
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.		
<input checked="" type="checkbox"/> I am an attorney or agent of record. Registration number <u>47,121</u>		
 <u>Kelko K. Takagi</u> Typed or printed name		
<u>(202) 293-7060</u> Telephone number		
<u>March 20, 2009</u> Date		

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of Docket No: Q78133  
Keisuke KII, et al.  
Appln. No.: 10/698,438 Group Art Unit: 1794  
Confirmation No.: 2685 Examiner: Victor S. CHANG  
Filed: November 3, 2003  
For: PARTIALLY CROSSLINKED ADHESIVE-SUPPORTED POROUS FILM FOR BATTERY  
SEPARATOR AND ITS USE

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**MAIL STOP AF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated October 22, 2008, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue: (1) Claims 1, 2, 4, 6 and 8 are still rejected under 35 U.S.C. §102(b) as allegedly being anticipated by JP 10-183085 ("JP '085") and (2) claim 7 rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over JP '085.

Appellants respectfully requests reconsideration of the above rejections for the following reasons.

Claim 1 is directed to a partially crosslinked adhesive-supported on a porous film for battery separator, consisting essentially of a porous film substrate having supported thereon partially crosslinked adhesive that is partially crosslinked by preparing a reactive polymer

having a functional group in the molecule and capable of being crosslinked upon reaction with a polyfunctional compound having reactivity with the functional group and then reacting the reactive polymer with a polyfunctional compound.

It is respectfully submitted that claim 1 excludes the presence of a tackifier and the presence of the tackifier (i.e., the binder of JP '085) would have a negative effect on the claimed invention.

In order to demonstrate the negative effect of a tackifier on the claimed invention, a Declaration under 37 C.F.R. § 1.132 was submitted on August 22, 2008. Batteries were prepared using electrolytes containing a tackifier and not containing a tackifier. The batteries using electrolytes containing a tackifier exhibited a faster degradation in discharge capacity as compared to a battery using an electrolyte having no tackifier. Based on this evidence, which can be extrapolated to the claimed battery separator, not only is it unsuitable to use a tackifier not only in the battery, but also in the adhesive for a battery separator.

Additionally, since JP '085 does not disclose or suggest the composition for a battery separator, JP '085 is distinguishable from the present invention.

The Examiner asserts that the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause.

However, it is submitted that "any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation" (emphasis added). See MPEP § 2111.02(I). In this case, the recitation of a battery separator is a structural

element recited in the preamble of the claim and this element gives the claim life and meaning.

For example, in *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951), the preamble reciting “[a]n abrasive article” was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated “it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an ‘abrasive article.’” Therefore, the preamble served to further define the structure of the article.

Similarly in the present case, it is by the phrase “battery separator” in the present claims that it can be known that the subject matter defined by the claims is comprised as a battery separator and that every union of an adhesive layer and porous film is not a battery separator.

For at least the above reasons, it is submitted that JP '085 does not anticipate claim 1.

Claims 2, 4, 6, 7, and 8 and depend, directly or indirectly, from claim 1, and thus, it is respectfully submitted that these claims are patentable for at least the same reasons as claim 1.

Further, with respect to the official notice taken with respect to the rejection of claim 7, the Examiner asserts that Applicants must specifically point out the supposed errors in the Examiner's Official notice, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.

It is respectfully submitted that Appellants have continued to point out the errors in the Examiner's Official Notice. The Examiner simply states “that reduced adhesive surface coverage

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U.S. Application No. 10/698,438**

**Attorney Docket Q78133**

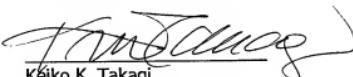
is common and well known, motivated by the desire to adjust the amount of adhesiveness and/or a reduced cost". Appellants submit that, with respect to the function of a battery, it is preferable that the supporting ratio of an adhesive is lower, but rather the contrary is preferable when adhesion to a battery is considered. Thus, the Examiner's statement that reduced surface coverage is common and well known motivated by the desire to adjust the amount of adhesiveness and/or a reduced cost is in error since it is overbroad and generalized. More specifically, the Examiner's "Official Notice" is simply conclusory.

In addition, official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. Such is not the case.

Further, the Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. *See* MPEP § 2144.03.

For at least the above reasons, Appellants respectfully request reconsideration of the rejections under 35 U.S.C. § 103(a).

Respectfully submitted,



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